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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,266	07/24/2003	Shigekatu Sato		7601

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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/627,266

Applicant(s)

SATO, SHIGEKATU

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 1 & 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 08/05/02. It is noted, however, that applicant has not filed a certified copy of the Japanese H14-226801 application as required by 35 U.S.C. 119(b).

Specification

2. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with deficiencies that include incomplete sentences, misspelled words and sentences that are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms, incomplete sentences and improperly hyphenated words used in the specification are: As to the improperly hyphenated words, on page 1 @ line 24, "mo-lding", page 2, @ line 18, "crossconta-mination", page 3 @ line 2, "proce-ssing", @ line 4, "cle-aning", @ line 19, "effe-ct", @ line 31, "scare-cely", etc.(see also pages 4, 5 & 11-35); As to the misspelled words, @ page 2, lines 34 & 36, "operater" should read "operator", on page 3 @ line 30, "tention" should read "tension", @ line 31, "scarecely" should read "scarcely", @ line 36, "disclosed" should read "disclosed", page 4, @ line 7, "excerts", page 5, @ lines 9, 10, 11 & 14, respectively, "buthyl" should read "butyl", "penthyl" should read "pentyl", "octhyl" should read "octyl", "eater" should read "ester", etc.(see also pages 11-35); As to sentences that are grammatically deficient, on page 3, line 26, "of" should be inserted between "consisting" and "a", @ line 31, "was" should be replaced with "were", on page 4, lines 7-9 and @ line 21, "the" should be inserted in front of "inside"(see also pages 5 and 11-35). Furthermore, the margins are not consistently uniform. A substitute specification to the substitute specification filed on 02/17/04 including the claims is required pursuant to 37 CFR 1.125(a) because the substitute specification(02/17/04) is replete with errors as set forth supra.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and (c)

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification, as far as the Examiner can tell, does not provide proper antecedent basis for "0.1-10 parts by weight of a amino group containing compound" per claim 2 (C). See page 24, lines 27-32.

Claim Objections

5. Claims 1 & 2 are objected to because of the following informalities: In claim 1 @ line 3, "comprising" should be replaced with "comprising", @ line 5, the conjunctive "and" should be inserted after "resin" and @ line 12, the indefinite article "a" should be inserted before "hydrocarbon"; In claim 2 @ line 3, "which" should be deleted, @ line 4, "comprising" should be replaced with "comprising" and @ line 6, "aminogroup containing" should be replaced with "amino group-containing". Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) The recited "the plastic processing machine" per claim 1 constitutes indefinite subject matter as per there being insufficient antecedent basis for this limitation in the claim.

B) The recited "general formula (1)" per claim 1 constitutes indefinite subject matter as per it not being apparent if or how said objectionable term "general" further limits the claims, said term being relative and not absolute.

C) The recited "selected from group consisting of hydrogen and hydrocarbon group" per claim 1 constitutes indefinite subject matter as per a) the use of language inconsistent with proper Markush terminology, i.e., the definite article "the" should be inserted between "from" and "group". When materials recited in a claim are so related as to constitute a proper Markush group, they should be recited in the conventional manner, or in the alternative. For example, "wherein R is a material selected from the group consisting of A, B, C and D" is a proper limitation, or alternatively, "wherein R is A, B, C or D" is also proper. See M.P.E.P. § 2173.05(h).

b) It is suggested that the indefinite article "a" be inserted before "hydrocarbon group" so as to engender claim language clarity.

D) The recited "positive integers independently from 0 to 30 whose sum is from 6 to 80" per claim 1 constitutes indefinite subject matter as per it not being readily ascertainable as to how "0" further limits the antecedently recited "positive integers". Further, the recited "whose sum is from 6 to 80" engenders awkwardly expressed claim language. The following language is suggested, "wherein a, b, c, d, e and f, independently, are integers from 0 to 30 with the proviso that the sum of $a + b + c + d + e + f$ is from 6 to 80".

E) The recited "A purging method of a contaminant in the plastic processing machine by passing the resin composition of claim 1 or 2 through inside of said plastic processing machine" per claim 3 constitutes indefinite subject matter as per being incomplete for omitting essential

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steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are recited at least @ page 27, lines 4 through 27. Further, claim 3, in its entirety, engenders grammatically deficient and awkwardly expressed claim language.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1 and 2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 10/627,267. Although the conflicting claims are not identical, they are not patentably distinct from each other because the antistatic agent characterized as containing a borate ester of polyoxyalkylene expressed by the formula (1)(claim 1), the antistatic agent according to claim 1, further comprising an amino group-containing compound(claim2), an antistatic plastic resin composition characterized as comprising (a) 100 parts by weight of a thermoplastic resin and (B) 0.1-10 parts by weight of an antistatic agent described in claim 1(claim 3), an antistatic plastic resin composition according to claim 3, further comprising (C) 0.1-10 parts by weight of an amino group containing compound(claim 4) and an antistatic plastic resin formed product(claim 5) per the claims of copending application 10/627,267 overlaps in scope with the resin composition for purging away contaminant in a plastic processing machine comprising (A) 100 parts by weight of a thermoplastic resin and (B) 0.1-10 parts by weight of a borate ester of polyoxyalkylene expressed by the formula (1)(claim 1) and a resin composition,

further comprising (C) 0.1-10 parts by weight of an amino group-containing compound(claim 2) per the instantly claimed invention. The use of the claimed invention of copending '267 for purging away contaminants in a plastic processing machine would be expected since the components of the invention, as claimed, per copending '267 are essentially the same as the components of the resin composition per the instantly claimed invention This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Double Patenting

10. Claim 3 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 10/627267 in view of JP 2-180941(ABSTRACT). It is known to use thermoplastic resin compositions containing borate compounds for cleaning moulding machines(removing contaminants) per JP'941(Abstract). Therefore, the use of the thermoplastic resin composition per the claims of copending application '267, similar to the thermoplastic resin composition of JP'941, for removing(purging) contaminants would have been obvious to the skilled artisan and with a reasonable expectation of success.

11. This is a provisional obviousness-type double patenting rejection.

Conclusion

12. The prior art to Leung et al(U.S. 5,236,514) and Saito(U.S. 6,235,821 B1) listed on the attached FORM PTO 892 is cited as of interest in teaching the use of thermoplastic resin compositions for purging and considered merely cumulative to the prior art supra. The prior art to Nunn Jr., et al(U.S. 3,316,287), Nunn Jr., et al(GB 1,090,565), Askew et al(U.S. 4,141,851), Tanizaki et al(U.S. 4,298,488), Askew et al(U.S. 4,450,087) and Toshimichi et al(JP61-083293), listed on the attached FORM PTO 892, is cited as of interest in teaching borate ester compounds which appear to overlap in scope with the claimed borate ester compound. A rejection in the future, based on this prior art, may be made. However, since a valid rejection is outstanding on

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this record, a rejection at this time is not being made. The remainder of the additional prior art listed on the attached FORM PTO 892 is cited as of being illustrative of the general state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571)272-1110. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Judy M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
04.27.04